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PATENT
Attorney Docket No.: 040180-000140US

TOWNSEND and TOWNSEND and CREW LLP

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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| In re application of: | Examiner: Son T. Nguyen |
| Donald L. Peinetti et al. | Art Unit: 3643 |
| Application No.: 10/830,174 | APPEAL BRIEF UNDER 37 CFR §41.37 |
| Filed: April 21, 2004 | |
| For: Method and Apparatus for Varying Animal Correction Signals | |

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant offers this Brief further to the Notice of Appeal mailed May 9, 2007.

1. Real Party in Interest

The real party in interest is Innotek, Inc., the assignee of the present application.

2. Related Appeals and Interferences

An appeal in related application 11/355,541 is currently pending.

3. Status of Claims

Claims 1, and 3-12 are currently pending in the application. Claims 2 and 13-20 have been cancelled. All of the pending claims stand rejected pursuant to a Final Office Action mailed November 9, 2006 (hereinafter "the Final Office Action") as well as the first Advisory Action mailed on March 20, 2007 and the second Advisory Action mailed on April 17, 2007.

The rejections of each of claims 1, and 3-12 are the subject of this appeal. A copy of the claims as rejected is attached as an Appendix.

4. Status of Amendments

The amendments filed on March 9, 2007 were not entered.

5. Summary of Claimed Subject Matter

In the following summary, Appellant has provided exemplary references to sections of the specification and drawings supporting the subject matter defined in the claims as required by 37 C.F.R. §41.37. The specification and drawings also include additional support for other exemplary embodiments encompassed by the claimed subject matter. Thus, these references are intended to be illustrative in nature only.

The claimed apparatuses relate to various embodiments of the invention for controlling an animal. A collar receiver can be worn by an animal to determine when an animal is located in a zone that the animal should not be located in. When the animal does not respond to a first sequence of correction signals and thus remains in the zone to be avoided, a second sequence of correction signals can be applied in order to annoy the animal into moving out of the zone. A random time interval generator is coupled with the correction signal generator so as to generate the second sequence of correction signals.

A. Independent Claim 1

Independent claim 1 relates to an apparatus for controlling an animal. The apparatus comprises an animal collar assembly worn by an animal (Fig. 3; paragraph [0059] at page 12, line 30-31); a detector for detecting a transmitted signal indicating said detector is located within a first zone (Fig. 19; paragraph [0084] at page 23, lines 9-11; paragraph [0085] at page 23, lines 28-29); a correction signal generator coupled with said detector and configured to apply a first sequence of correction signals transmitted to said animal for controlling said animal (Fig. 19; paragraph [0084] at page 23, lines 11-12; paragraph [0085] at page 23, lines 30-31); wherein said correction signal generator is further configured to apply a second sequence of correction signals transmitted to said animal for controlling said animal and wherein said second sequence is different from said first sequence (Fig. 19; paragraph [0084] at page 23, lines 16-20; paragraph [0085] at page 23, lines 31-33); wherein said correction signal generator is further configured to apply said second sequence of correction signals if said animal does not leave said first zone in response to said first sequence of correction signals after a period of time (Fig. 19; paragraph [0084] at page 23, lines 16-20; paragraph [0085] at page 23, lines 31-33); and a random time interval generator coupled with said correction signal generator and wherein said second sequence of correction signals is applied in response to said random time interval generator (Fig. 19; paragraph [0084] at page 23, lines 20-24; paragraph [0085] at page 23, lines 31-33).

6. Grounds of Rejection to be Reviewed on Appeal

A. Whether claims 1 and 3-12 are unpatentable under 35 USC §102 in view of Anderson (US Patent 6,232,880)

7. Argument

A. Whether claims 1 and 3-12 are unpatentable under 35 USC §102 in view of Anderson (US Patent 6,232,880)

The final office action mailed on November 9, 2006 rejected claims 1 and 3-12 under 35 USC §102 as anticipated by the Anderson reference. The Applicant had noted to the

Examiner in response to the non-final office action that the Anderson reference fails to teach "**a random time interval generator coupled with said correction signal generator and wherein said second sequence of correction signals is applied in response to said random time interval generator**" as recited in claim 1. The Examiner replied in the final office action that the Anderson reference inherently taught "**a random time interval generator coupled with said correction signal generator and wherein said second sequence of correction signals is applied in response to said random time interval generator.**" See final office action mailed on November 9, 2006 at page 6, lines 18-19.

First, it is noted that the Anderson reference fails to teach "**a random time interval generator coupled with said correction signal generator and wherein said second sequence of correction signals is applied in response to said random time interval generator.**" The Examiner characterized Anderson as allegedly teaching this limitation at Col. 7, ll. 54-56; Col. 8, ll. 15-22, 50-67 of Anderson. However, there is no mention in Anderson of a *random time interval generator*. In fact, the cited portions of Anderson appear to teach only that application of a stimulus can be administered to a random *side* of an animal (see Anderson at Col. 7, ll. 54-56) in order to prompt the animal to move when there is no preferred direction that the animal should move. Applying stimuli to a random *side of the animal* is completely different from applying the signals in response to a *random time interval generator*. Clearly, Anderson does not disclose a random time interval generator as recited in Claim 1. Therefore, Anderson does not teach "**a random time interval generator coupled with said correction signal generator and wherein said second sequence of correction signals is applied in response to said random time interval generator.**"

The non-final office action recognized that Anderson does not explicitly recite a random time interval generator when it argued on page 6, lines 18-19 of the final office action mailed on November 9, 2006 that the Anderson reference **inherently** taught a random time interval generator. Appellant appeals this determination and rejection.

The principle of inherency under 35 USC §102 is a very limited principle that requires that a reference must necessarily teach an element without exception. This is a

longstanding principle articulated in numerous cases before the Court of Appeals for the Federal Circuit and also noted by the MPEP. For example, the Manual of Patent Examining Procedure, Original Eighth Edition, Revised May 2004 states in section 2112 at pages 2100-54 through 2100-55:

> "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" In re Robertson, 169 F. 3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). . . .
>
> In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)."

> See Manual of Patent Examining Procedure, Original Eighth Edition, Revised May 2004 states in section 2112 at pages 2100-54 through 2100-55 (emphasis in the original).

As noted above, the Anderson reference does not necessarily dictate that time intervals are varied between correction signals. Thus, Anderson does not inherently teach that time intervals will be varied. Rather, time intervals between application of the correction signal in Anderson could still be at regular predetermined intervals -- only the side of the animal to which the correction signals is applied would be random.

In fact, application to a random side of the animal is what Anderson was contemplating. This is explained in Anderson, for example, in the following citation:

> "The determination of the side to which the stimulus is applied is based upon the animal's position (within the zone of inclusion or exclusion), the angle of incidence between the animal's direction of travel and the threshold line (or boundary line), and the animal's expected response to the bilateral stimulation (through training or instinct). If the animal is within the area of inclusion and the angle of incidence is acute or substantially less than 90.degree. (generally, less than about 80.degree.), then the aversive stimuli will be applied on the side of the animal that will move the animal into the obtuse angle it forms with the threshold line or boundary line. This will maximize the distance of separation between the threshold line and the animal's position with the minimum change in the animal's bearing. If the animal's bearing of movement toward a threshold or boundary line is approximately perpendicular (generally between about 80-100.degree.), **the side to which the stimuli are applied once the animal contacts the line is determined entirely randomly** by the microprocessor. This logic

> also holds if the animal approaches an intersection of two threshold or boundary lines. The stimuli are applied to the side of the animal to produce movement away from the closest line (i.e. the side adjacent the smallest angle). If the animal's angle of approach to the lines bisects the angle of intersection of the two lines (such as 45.degree. in a right angle corner), **the side to which the stimuli are applied once the animal penetrates the boundary is chosen at random** or arbitrarily."
>
> See Anderson (US Patent 6,232,880) at column 7, lines 30-56 (emphasis added).

Similarly, at column 8, lines 30-53, the Anderson reference states:

> "In an alternative embodiment, the boundary lines can be programmed to surround individual animals wearing the device of the invention. With this configuration the invention can be used to control animal density among animal groups as well as potentially manage specific mating pairs among multi-sire groups. In this embodiment, the boundary lines are not static but are established a predetermined distance from the subject animals. In contrast with the previously described embodiments using fixed boundary lines, the changing positions of the animals relative to one another will necessitate that the GPS data identifying the position of each animal be compared with the other animals. Consequently, the position data for each animal must be transmitted (using an RF transponder for example) to the microprocessor's of the other animals and/or to a central microprocessor effective for determining the relative position's of the animals. **Upon determination that one animal is approaching a second animal from which it is to be separated, aversive stimuli are**

> **administered in the same manner as described above. However, if the density of the animals becomes exceedingly high such that a subject animal is surrounded by more than one substantially equidistant boundary lines, then the unit will default to a random application of the aversive stimuli."**
> See Anderson at column 8, lines 30-53 (emphasis added).

Thus, Anderson does not inherently teach the claim element "a random time interval generator coupled with said correction signal generator and wherein said second sequence of correction signals is applied in response to said random time interval generator". All that Anderson teaches is application to a random side of an animal when no preferred choice of direction exists for guiding an animal.

Since the Anderson reference does not inherently teach "a random time interval generator coupled with said correction signal generator and wherein said second sequence of correction signals is applied in response to said random time interval generator" Anderson does not teach each and every element of claim 1. Therefore, the final office action and the advisory action have failed to establish a prima facie case of anticipation under 35 USC §102. Therefore, appellant requests that the final rejection of claims 1, and 3-12 under 35 USC §102 be reversed and that claims 1 and 3-12 be allowed.

8. Conclusion

Appellant believes that the above discussion is fully responsive to all grounds of rejection set forth in the application. Please deduct the requisite fees pursuant to 37 C.F.R. §1.17(c) from Deposit Account 20-1430 and any additional fees that may be due in association with the filing of this Brief.

Respectfully submitted,



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## CLAIMS APPENDIX

The claims pending in the application are as follows:

1. (Previously presented) An apparatus for controlling an animal, said apparatus comprising:

an animal collar assembly worn by an animal;

a detector for detecting a transmitted signal indicating said detector is located within a first zone;

a correction signal generator coupled with said detector and configured to apply a first sequence of correction signals transmitted to said animal for controlling said animal;

wherein said correction signal generator is further configured to apply a second sequence of correction signals transmitted to said animal for controlling said animal and wherein said second sequence is different from said first sequence;

wherein said correction signal generator is further configured to apply said second sequence of correction signals if said animal does not leave said first zone in response to said first sequence of correction signals after a period of time; and

a random time interval generator coupled with said correction signal generator and wherein said second sequence of correction signals is applied in response to said random time interval generator.

2. (Canceled)

3. (Original) The apparatus as described in claim 1 wherein said second sequence of correction signals comprises a randomized sequence of signals.

4. (Original) The apparatus as described in claim 3 wherein said randomized sequence of signals comprises random intervals between application of each successive signal in said randomized sequence of signals.

5. (Original) The apparatus as described in claim 1 wherein said correction signal generator is configured to transmit at least one sound in the audible range of said animal as said first sequence of correction signals and as said second sequence of correction signals.

6. (Original) The apparatus as described in claim 1 wherein said correction signal generator is configured to transmit an electrical stimulation to said animal in said first sequence of correction signals and in said second sequence of correction signals.

7. (Original) The apparatus as described in claim 6 wherein prior to generation of said second sequence of correction signals, said correction signal generator is configured to generate successive sets of correction signals wherein each of said successive sets of correction signals has a voltage magnitude greater than the immediately preceding set of corrections signals.

8. (Original) The apparatus as described in claim 1 wherein each of said signals in said first sequence of correction signals is separated by a separation interval and wherein said separation interval decreases with each successive signal of said first sequence of correction signals.

9. (Original) The apparatus as described in claim 1 wherein said detector is further configured to determine a period of time in said first zone after detection of said transmitted signal indicating said detector is located within said first zone.

10. (Previously presented) The apparatus as described in claim 9 wherein said correction signal generator is configured to apply said second sequence of correction signals if said time exceeds a predetermined period of time.

11. (Original) The apparatus as described in claim 1 wherein said detector for detecting said transmitted signal is configured to detect a strength of said transmitted signal and wherein said strength of said transmitted signal is related to positioning within said first zone.

12. (Original) The apparatus as described in claim 11 wherein said correction signal generator utilizes said strength of said transmitted signal to determine the magnitude of the initial correction signal applied.

13-20. (Canceled)

## EVIDENCE APPENDIX

Not included.

**RELATED PROCEEDINGS APPENDIX**

Not included.